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		Application Number	09/783,666
		Filing Date	02/14/2001
		First Named Inventor	Reiner Kraft
		Art Unit	2154
		Examiner Name	Mohammad A. Siddiqi
Total Number of Pages in This Submission		Attorney Docket Number	ARC920010009US1

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Signature		
Date	08/17/2005	

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Typed or printed name	Samuel A. Kassatly	
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FEE TRANSMITTAL

For FY 2005

 Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT

(\$)
0

Complete if Known

Application Number	09/783,666
Filing Date	02/14/2001
First Named Inventor	Reiner Kraft
Examiner Name	Mohammad A. Siddiqi
Art Unit	2154
Attorney Docket No.	ARC920010009US1

METHOD OF PAYMENT (check all that apply)

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FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fees Paid (\$)
Utility	300	150	500	250	200	100	_____
Design	200	100	100	50	130	65	_____
Plant	200	100	300	150	160	80	_____
Reissue	300	150	500	250	600	300	_____
Provisional	200	100	0	0	0	0	_____

2. EXCESS CLAIM FEES

Fee Description

Each claim over 20 (including Reissues)

Each independent claim over 3 (including Reissues)

Multiple dependent claims

Total Claims	Extra Claims	Fee (\$)	Fee Paid (\$)	Small Entity Fee (\$)	Fee (\$)
- 20 or HP =	0	x 50	= 0	50	25

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims	Extra Claims	Fee (\$)	Fee Paid (\$)	Multiple Dependent Claims	Fee (\$)	Fee Paid (\$)
- 3 or HP =	0	x 200	= 0	360	0	0

HP = highest number of independent claims paid for, if greater than 3.

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
- 100 =	0	/ 50 = 0 (round up to a whole number)	x 250 = 0	0

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): _____

SUBMITTED BY

Signature

Registration No.
(Attorney/Agent) 32,247

Telephone 408-323-5111

Name (Print/Type) Samuel A. Kassatly

Date 08/17/2005

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Attorney Docket No.: ARC920010009US1

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Samuel A. Kassatly

Typed or printed name of person signing Certificate

32,247
Registration Number, if applicable

408-323-5111
Telephone Number

PATENT

IN THE UNITED STATES PATENT
AND TRADEMARK OFFICE

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AUG 18 2005

BOARD OF PATENT APPEALS
AND INTERFERENCES

Title: "Automatic Relevance-Based Preloading of Relevant
Information in Portable Devices"

Applicant(s): Reiner Kraft et al.

Attorney Docket No.: ARC920010009US1

Serial No.: 09/783,666

Examiner: Mohammad A. Siddiqi

Filed: 02/14/2001

Art Unit: 2154

Board of Patent Appeals and Interferences
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450.

APPELLANT'S REPLY BRIEF TO EXAMINER'S ANSWER

Dear Sir:

This Reply Brief is submitted in response to the Examiner's Answer of **July 5, 2005.**

The claims on Appeal are listed in **Appendix A.**

ARGUMENTS

Appellants reassert and incorporate all the arguments made in the Appeal Brief, and further address the Examiner's new arguments and grounds of rejection that are presented in the **Examiner's Answer of July 5, 2005.**

Issues on Appeal

The two issues/rejections currently on appeal are as follows:

1. Whether claims 11, 19, and 21 were properly rejected under 35 U.S.C. 101 on the ground that the claimed invention is directed to non-statutory subject matter.
2. Whether claims 1-28 were properly rejected under 35 U.S.C. 103(a) as being unpatentable over DeLorme et al. (5,948,040) (hereinafter DeLorme) in view of Liddy et al. (6,026,388) (hereinafter Liddy).

First Issue: Claims Rejection under 35 USC § 101

The Examiner rejected claims 11, 19, and 21 under 35 U.S.C. 101 on the ground that:

"the claimed invention is directed to non-statutory subject matter. The language of the claims raises a question as to whether the claims are directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful and tangible result. The various estimators, retriever, and loader are software constructs performing various functionalities. These functionalities do not manipulate any hardware or tangible entity. Therefore, these

software constructs are non statutory entities as detailed in MPEP 2106." (Emphasis added)

Appellants respectfully traverse this rejection and submit the following arguments in support of the compliance of the rejected claims with 35 U.S.C. 101.

First Argument:

Appellants submit that, contrary to the Examiner's assertion, the steps and elements of the rejected claims actually recite and manipulate at least one hardware or tangible entity, namely the "computing device". More specifically, exemplary claim 11 recites "automatically preloading selected sorted data to the computing device." The computing device qualifies as a hardware and/or tangible entity, and thus claim 11 (and similarly the other independent claims 19 and 21) satisfy the statutory requirement of 35 U.S.C. 101.

Second Argument:

Appellants submit that MPEP 2106 that is relied upon by the Examiner actually supports the Appellants' position of compliance with 35 U.S.C. 101. More specifically, MPEP 2106 states that:

"A process that **CONSISTS SOLELY** of the manipulation of an abstract idea is not concrete or tangible." (Emphasis added)
However, as indicated in the First Argument above, the present invention recites preloading the information to a computing device. As a result, the rejected claims cannot be said to be to consist solely of the manipulation of an abstract idea.

Appellants submit that the interpretation of the lack of concreteness and tangibility under MPEP 2106 is quite restrictive. More specifically, **MPEP 2106 uses two consecutive, specific terms, with very restrictive meaning.**

The first term is "consists" and the second term is "solely". Both of these terms expressly limit the Examiner's ability to expand his/her application of MPEP 2106 to the claims under review.

In particular, so long as the rejected claims recite at least one hardware or tangible entity, then the steps or elements of the claims cannot be said to consist solely of the manipulation of an abstract idea. Consequently, the rejected claims satisfy the requirements of 35 U.S.C. 101.

Third Argument:

Furthermore, Appellants submit that the Examiner has not established a prime facie case that the claimed invention as a whole is directed to an abstract idea. More specifically, MPEP 2106 states the following:

"Office personnel have the burden to establish a *prima facie* case that the claimed invention as a whole is dedicated to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitation to a practically application in the technological arts should it be rejected under 35 U.S.C. 101 ... Further, when such a rejection is made Office personnel must expressly state how the language of the claims has been interpreted to support the rejection .. Office personnel should therefore focus their efforts on pointing out statement made in the specification that identify all practical applications for the invention .. An applicant may assert more than one practical application, but only one is necessary to satisfy the utility requirement ..."

Appellants respectfully submit that the instant invention presents numerous useful and practical applications, one of which is the following application that is explained in the Appeal Brief:

"Portable devices, in order to be small, have a limited amount of power source (i.e., battery) and memory and storage space. Consequently, every piece of information stored on a mobile device needs to be relevant to the user's needs, especially when the user is

in a network-disconnected mode such as on a trip. Page 1, line 27-page 2, line 2."

Since the present invention offers at least the foregoing useful and practical application, it must be deemed to be in satisfaction of 35 U.S.C. 101.

Fourth Argument:

In addition, Appellants further submit that the Examiner has not met the requirement imposed by MPEP 2106, namely that "Office personnel must expressly state how the language of the claims has been interpreted to support the rejection." To Appellants' best understanding of the Examiner's rejection, the rejection is devoid of any claim interpretation in support of the rejection under 35 U.S.C. 101. As a result, Appellants respectfully request that the rejection under 35 U.S.C. 101 be withdrawn.

Fifth Argument:

As a last resort, and though not necessary, but in an effort to maintain this case within the jurisdiction of the Board of Appeals, for a more expeditious determination of the allowability of the claims on file, Appellants are willing to merge independent claims 11, 19, and 21, with their respective dependent claims 12, 20, and 22, if the Board determines that such a strategy would be acceptable to satisfy the requirement of 35 U.S.C. 101.

Since the Examiner did not reject dependent claims 12, 20, and 22 under 35 U.S.C. 101, then, if the limitations/elements of these dependent claims were to be merged with their respective independent claims 11, 19,

and 21, the resulting claims would clearly overcome the Examiner's rejection.

Appellants wish to emphasize that this strategy is a procedural step to overcome the Examiner's rejection, though it is not necessary to satisfy the requirement of 35 U.S.C. 101.

Second Issue: Claims Rejection under 35 USC § 103

In section 10 of the Examiner's Answer, claims 1-28 were rejected under 35 U.S.C. 103(a) as being unpatentable over DeLorme et al. (U.S. Patent No. 5,948,040) (hereinafter DeLorme) in view of Liddy et al. (U.S. Patent No. 6,026,388) (hereinafter Liddy).

Appellants submit that this rejection is substantially similar, if not substantively identical to the rejection made in the final office of July 21, 2004. As a result, this rejection does not offer any new ground of rejection or arguments, and thus Appellants incorporate by reference the arguments made in the Appeal Brief, without duplicating the previous arguments herein.

Appellants will now address the new arguments that have been raised by the Examiner in Section 12 of the Examiner's Answer.

First Argument

Appellants' Argument in the Appeal Brief:

Threshold does not require any further clarification (Page 6).

Examiner's Response in the Examiner's Answer:

According to the applicants description of "threshold" in the context of claims it is used as a filtering criteria ("a relevance score higher than the relevance threshold"). Applicant's argument is persuasive, which also has clarified the functionality of the term "setting threshold", therefore, the objection is withdrawn.

Appellants acknowledge the Examiner's withdrawal of the objection, and confirm that, as used in the instant application, a "relevance threshold" implies a "relevance limit".

Second Argument

Appellants' Argument in the Appeal Brief:

DeLorme does not disclose automatic relevance-based preloading data (page 11).

Examiner's Response in the Examiner's Answer:

DeLorme's system discloses the following software capabilities: (1) a map display graphic user interface enabling the TRIPS user to zoom ... to pan or shift seamlessly to other map locations ... and to locate named places, zip code or phone exchange areas, street addresses, or other landmarks and ordinary language geographic location and direction identifiers on the map display; ... (4) electronic communication or transfers of discrete, compact files ... and/or (5) transferring of geographic data files to and from auxiliary devices.

In response to the applicant's arguments, DeLorme teaches automatic relevance-based preloading (... hotels, camp grounds, restaurant etc. are relevant to the POI's of planned TRIP, transferring data files to handheld digital aid is automatic, it **is done by the software using electronic communication... Software is coded instructions (programs) that make a computer do useful work, which is an automatic process in itself.**

Appellants' Counter Argument:

The preamble of the claims on file clarifies that the claimed subject matter of the invention relates to the **automaticity** of the operation of the claimed system, computer program product, and process. Appellants respectfully submit that, in interpreting the claims on file, such automaticity, **that is the absence of the user's interception or interference**, must be persistently kept in mind, in order to avoid an overly broad and unjustifiable interpretation of the claims.

More specifically, the fact that the user of the DeLorme system uses a **map display graphic user interface** to zoom, pan, or shift through the information, implies that it is the user who selects the desired information, and that it is the user who determines or contributes to the determination of the relevance of the information that is to be preloaded. Consequently, the DeLorme preloading process (as compared to the presently claimed system/process) is not automatic.

As it is best understood from the Examiner's comments, DeLorme is said to automatically transfer the information because it uses a computer. Appellants respectfully traverse this line of reasoning in view of the

limitations of the claims on file. More specifically, the Examiner seems to completely overlook the terms "**relevance-based**" and has focused mainly (or exclusively) on the automatic transfer. Appellants wish to make it clear that the automatic transfer is performed only if the information is relevant. In other terms, the user of DeLorme manually locates the information that is relevant to him/her, such as points of interest like restaurants. Then, the user manually requests that this relevant information be transferred to a computing device. Thereafter, the transfer of the manually selected information is done automatically.

However, the manual selection of the points of interest and the manual request to transfer the information which the user manually selected to be relevant, does not and cannot qualify as "automatic." This is contrary to the present invention, as described in the instant application, where the user inputs the desired parameters, and lets the computer automatically determine the relevance of the information and the automatic transfer of this relevant information to a computing device, such as a PDA. Reference is made for example, to page 6, lines 9 - 12 of the instant application: "FIG. 1 illustrates a high level architecture of an exemplary system 100 for **automatically selecting and pre-loading** proximity-based relevant information onto one or more portable devices 135." As a result, the instant application makes it clear that automatic relevant-based preloading includes **automatically selecting and pre-loading, and not simply the automatic transfer of information.**

Third Argument

Appellants' Argument in the Appeal Brief:

DeLorme does not disclose analyzing the relevance (page 12).

Examiner's Response in the Examiner's Answer:

DeLorme's system teaches ... the addition of temporal and/or transactional travel information and database relations ... data records include discrete temporal and accounting data as well as geographic and topical information ... In response to the applicants' arguments, DeLorme teaches analyzing the relevance of the stored data to any or more of the currently scheduled tasks or person (...by addition of temporal and/or transactional travel information and database... Col. 49, lines 2-3) which is similarly disclosed in the applicant's specification on page 2, lines 20-22. It is the examiner's understanding that a planned trip in itself is a scheduled task.

Appellants' Counter Argument:

In the Appeal Brief, Appellants requested that the Examiner consider the rejected independent claims, as exemplified by claim 1, as a whole, including the analysis step that is recited therein. However, it appears that the examiner still focused on a segment of claim 1, without considering the claim as a whole.

More specifically, Appellants have recited in claim 1, the following explanation of the analysis step, which was not considered by the Examiner: "wherein analyzing the relevance score comprises estimating a proximity of the stored data items to any one or more of persons or current scheduled tasks, based on

an association proximity measure and at least one proximity measure."

As a result, the question that needs to be addressed by the Examiner is whether, in DeLorme, the step of "adding the temporal information" qualifies as an analysis by estimating the proximity of the stored data to any one or more of persons or current scheduled tasks, based on an association proximity measure and at least one proximity measure." The answer is clearly in the negative, as DeLorme does not teach such an analysis by estimation as recited in the rejected claims.

Fourth Argument

Appellants' Argument in the Appeal Brief:

DeLorme does not disclose sorting based upon the relevance (page 13).

Examiner's Response in the Examiner's Answer:

In response to the applicants' arguments, DeLorme teaches sorting based upon the relevance to any one or more of the current scheduled task (Col. 49, lines 51-55). DeLorme reference reiterates the sorting and filtering techniques, which happens to be a well known process in the software and database art.

Appellants' Counter Argument:

Similarly to the previous argument, the Examiner's analysis strategy ignores the element as a whole, as required by the legal authorities above. As before, the Examiner has dissected the element into two subparts without providing any arguments to

connect the various subparts, in contradiction to the legal authorities that require the Examiner to consider the invention as a whole.

Applicants concede that sorting data was previously known, and that the relevance concept was also known. However, the present invention is not a simple recitation of these two elements independently from each other, but rather recites a combination of these elements as well as other elements in claim 1.

More specifically, Appellants have recited in claim 1, the following explanation of the analysis step, which was not considered by the Examiner: "wherein analyzing the relevance score comprises estimating a proximity of the stored data items to any one or more of persons or current scheduled tasks, based on an association proximity measure and at least one proximity measure."

As a result, the question that needs to be addressed by the Examiner is whether DeLorme teaches sorting based upon the relevance by estimating the proximity of the stored data to any one or more of persons or current scheduled tasks, based on an association proximity measure and at least one proximity measure." The answer is clearly in the negative.

Fifth Argument

Appellants' Argument in the Appeal Brief:

DeLorme does not disclose setting a predetermined relevance threshold (page 14).

Examiner's Response in the Examiner's Answer:

In response to the applicant's arguments, DeLorme teaches setting a predetermined threshold (... zip codes, phone exchange areas are interpreted as threshold or filtering criteria ... Col. 48, lines 5-33; Col. 49, lines 51-55). An ordinary person skilled in the art would interpret "setting a threshold" as a filtering criteria (... a relevance score higher than the relevance threshold... Brief, argument 8.1, page 5). Thereby, the examiner agrees with the applicant that "setting up threshold" is nothing more than a filtering criteria citing higher than a relevance limit.

Appellants' Counter Argument:

As explained by Appellants, the common use of the term "threshold" in the general context of the present invention, as understood by a person of ordinary skill in the field, implies a limit. As a result, zip codes and area codes cannot be considered as thresholds, even if the meaning of the term "threshold" were stretched to its maximum limit.

Appellants submit that the values described by DeLorme do not qualify as relevance threshold in that:

- (1) The calculated relevance score of the stored data is compared to the relevance threshold. DeLorme, on the other

hand, does not compare the zip code of the phone number to the calculated relevance score.

(2) According to the present invention, if the calculated relevance score were "higher" than the threshold, the data is automatically loaded. However, in DeLorme, if either the zip code (e.g., 410) were "greater" than a threshold zip code (e.g., 409), then the stored data is not automatically loaded.

Appellants submit that what the examiner refers to as relevance threshold in DeLorme could arguably be viewed as a "filter" but not a relevance threshold as intended to be used and as actually recited in the instant claim 1.

Appellants further submit that relevance reflects a relative relationship. In other terms, one item is relevant to another item. More clearly, an item is said to be relevant to another object if the value that compares both items is smaller than a threshold or limit. As a result, absolute values, such as the time of departure, time of arrivals, etc., that do not compare two values, do not qualify, under the present invention, as either threshold values or as relevance scores. This line of reasoning is also applicable to the next argument.

Sixth Argument

Appellants' Argument in the Appeal Brief:

DeLorme fails to disclose relevance score, and automatic preloading based on relevance score that is higher than the relevance threshold (page 15).

Examiner's Response in the Examiner's Answer:

Examiner respectfully disagrees, DeLorme teaches automatically preloading (... pre-arranged, transferring data files to handheld digital aid ... Col. 46, lines 55-67; Col. 48, line 10; lines 30-34) selected sorted data to the computing device with a higher than the relevance threshold (... intended departure time, when, where, who to visit, or what to do, head/top of the array, sorting ... Fig. 6, Col. 5, line 61; Col. 48, lines 25-33; Col. 53, lines 1-44; Col. 53, lines 15-44) which is similarly disclosed in the applicant's specification on page 2, lines 20-23, that describes pre-loads before the occurrence of a trip; page 10, lines 1-7 further clarifies preloading.

Appellants' Counter Argument:

As presented by Appellants in the Appeal Brief: The Examiner argues that DeLorme discloses "automatically preloading (pre-arranged, col. 46, lines 55-67, col 48, 30-33, transferring is preloading) selected sorted data to the computing device (col 48, lines 25-33) with a higher (array, sorting, fig 6, col 53, lines 1-44) than the relevance threshold (intended departure time, when, where, who to visit, or what to do, are the inherent threshold values in the context of this invention, fig 6, col 5, line 61, col 53, lines 15-44, col 48, lines 5-33)." Applicants respectfully traverse this rejection ground.

Similarly to the previous elements, the Examiner's analysis strategy ignores the element as a whole, as required by the legal authorities above. As before, the Examiner has dissected the element into subparts without providing any arguments to connect the various subparts, in contradiction to the legal authorities that require the Examiner to consider the invention as a whole.

Appellants further submit that the relevance score is well defined in the independent claims as: "wherein analyzing the relevance score comprises estimating a proximity of the stored data items to any one or more of persons or current scheduled tasks, based on an association proximity measure and at least one proximity measure." As a result, the Examiner is not allowed to redefine the terms "relevance score", and to expand its scope beyond what is intended by the Appellants and what is defined in the instant application.

As an example, the Examiner interprets "relevance threshold (... intended departure time, when, where, who to visit, or what to do, head/top of the array, sorting" to mean relevance threshold. As explained above, such absolute values do not qualify as thresholds or limits, as they do not provide the relevance scores that is comprised of the proximity of the stored data based on the association proximity measure and one proximity measure (as defined in the instant application).

Seventh Argument

Appellants' Argument in the Appeal Brief:

DeLorme does not disclose analyzing based on the association proximity and at least one proximity measure (page 16).

Examiner's Response in the Examiner's Answer:

In response to the applicant's arguments, DeLorme teaches that analyzing comprises estimating a proximity of the stored data items to any one or more of persons or current scheduled tasks, based on an association proximity measure and at least one proximity measure (...POI/EOI, Optimally arranged output, EOI arrays, temporal data... Col. 17, lines 1-44;Col. 53, lines 15-43) which is similarly disclosed in the applicant's specification on pages 3 and 4, where the applicant describes temporal, distance, and association proximities. Furthermore, Liddy discloses relevance score (Col. 4, lines 1-2). It would have been obvious to one of ordinary skill in the art at the time invention was made to combine the teachings of Liddy with DeLorme because it would provide optimal trip planner and the proximity decision will be based on the relevance score.

Appellants' Counter Argument:

Appellants respectfully submit that the Examiner's analysis strategy ignores the element as a whole, as required by the legal authorities above. As before, the Examiner has dissected the element into subparts without providing any arguments to connect the various subparts, in contradiction to the legal authorities that require the Examiner to consider the invention as a whole.

More specifically, the present invention makes a clear distinction between three proximity measures: "distance, time, and association."

Claim 1 specifies analyzing the relevance score by estimating a proximity of the stored data items based on an association proximity measure. As explained earlier, the association proximity measurement relates to people, who, for example, are explicitly indicated in the user's address book and to-do list. Refer to page 8, lines 6 -7 of the specification. DeLorme does not describe such "association proximity" measure.

Eight Argument

Appellants' Argument in the Appeal Brief:

The combination of DeLorme and Liddy does not disclose the present invention as a whole.

Examiner's Response in the Examiner's Answer:

The examiner disagrees for similar reasons as stated above.

Appellants' Counter Argument:

The Examiner argues that DeLorme discloses: "DeLorme fails to disclose relevance score. However, Liddy discloses relevance score (col 4, lines 1-2). Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to combine Liddy with DeLorme because it would provide optimal trip planner and the proximity decision will be based on the relevance score." Applicants respectfully traverse this rejection ground.

Appellants submit that the combination of DeLorme and Liddy does not yield the same or similar design as the present invention, as a whole. More specifically, the Examiner summarily states that the combination of both references is possible, but does not explain how the DeLorme design could

be changed to accommodate the relevance score concept. In particular, the Examiner did not explain how the DeLorme-Liddy combination performs the following steps:

- 1) automatically preloading selected sorted data to the computing device with a relevance score higher than the relevance threshold; and
- 2) wherein analyzing the relevance score comprises estimating a proximity of the stored data items.

In addition, Applicants respectfully submit that neither Liddy nor DeLorme provides some teaching or suggestion to support the combination of these two references. As a result, based on the legal authorities above, obviousness cannot be established.

Applicants incorporate by reference the presentation made earlier in support of the allowance of claim 1, and submit that the independent claims 11, 19, and 21 are similarly not obvious in view of combination of DeLorme and Liddy, for containing generally comparable elements and limitations. As a result, the independent claims 1, 11, 19, and 21 are allowable, and the claims dependent thereon are also allowable. Such allowance is respectfully requested.

Respectfully submitted,

Date: August 17, 2005
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